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REMARKS

Claims 1-7, 12-16 and 18-20 remain pending, and Claims 21-24 have been added. Claims 1, 12 and 21 are independent.

Applicants note with appreciation the withdrawal of the previous rejection of each of independent Claims 1 and 12 based upon *Kirmuss*, Beckert and Chuang.

Claims 1-7, 12-14 and 18-19 were rejected under 35 USC 103(a) as being unpatentable over newly-cited US Patent 7,061,371 (Shockley), US Patent 5,794,164 (Beckert et al.) and US Patent Application Publication 2003/0112929 A1 (Chuang). Claims 15, 16 and 20 were rejected as being unpatentable over Shockley, Beckert and Chuang and further in view of US Patent Application Publication 2003/0095688 A1 (Kirmuss).

In view of the foregoing amendments and the following discussion, each of the rejections is respectfully traversed and reconsideration is requested.

Independent Claim 1 is directed to an in-car video system, including a video camera fixably mounted to an automobile for capturing an image of an event and producing a corresponding video stream, a digital video recorder fixably mounted to the automobile, the digital video recorder having a receiving area being adapted to operably couple a flash memory card to the digital video recorder so that the flash memory functions as a digital video storage medium, and a controller coupled to the video recorder to control writing of data that is representative of the video stream to a flash memory to thereby generate a stored video record of the event, wherein the digital video recorder and controller are integrally packaged and positioned within a factory-sized radio opening of a production automobile having a police package option, and further wherein the digital video recorder is located in a passenger compartment of the automobile such that it is in a direct operative relationship with a user seated in the front seat of the automobile.

Claim 12 is directed to a method, in an automobile-mounted video system including a car-mounted camera, of operating a digital video recorder. The method includes the steps of receiving a flash memory card in a receiving area of the digital video recorder, the receiving area being adapted to operably couple the flash memory card to the digital video recorder so that the flash memory functions as a digital video storage medium, receiving a video stream of an event

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captured by the camera, converting the video stream to a form that is writable to the flash memory, writing the converted video stream to the flash memory to thereby store a record of the event on the flash memory, and fixably positioning the digital video recorder substantially within a dashboard area of the automobile so that the digital video recorder is located in the passenger compartment of the automobile and is in a direct operative relationship with a user seated in the front seat of the automobile.

As disclosed and claimed in the present invention, placing the digital video recorder (DVR) in the dashboard area of the car, puts it in a "direct operative relationship" with the operator (e.g., the police officer operating the vehicle and DVR) seated in the front seat of the vehicle. That is, the DVR is in the *passenger compartment* with the operator (just as the normal sound system is in the passenger compartment).

Shockley is directed to an automobile diagnostic system that monitors real-time sub-system components – specifically, a plurality of acoustic and video sensors, to detect noise levels and/or vibrations in sub-systems such as brakes, shocks, etc.

The Office Action acknowledged that Shockley fails to teach or suggest (1) "the use of a digital video recorder using flash memory", and (2) "the use of the digital video recorder and controller positioned within a factory-sized radio opening".

Although the Examiner acknowledges that Shockley does not specifically teach the installation in a DIN sized opening, the Examiner takes the position that Beckert teaches "a computer system has a housing sized to be mounted in a vehicle dashboard in a DIN location" (abst., col. 3, lines 5-11, col. 4, lines 4-9), and Chuang is relied upon as teaching the use of a compact flash memory.

As 'motivation' to combine the alleged teachings of Shockley, Chuang and Beckert the Action asserts (sentence bridging pages 3-4 of the Action) that "it would have been obvious...to replace the controller and video recorder of Shockley with the computer system of Beckert in order to provide a single system for performing not only diagnostics but other functions such as security and GPS as taught by Beckert", and, "to use flash media to store video as Chuang teaches flash media as an alternative to a tape recording apparatus".

Applicant respectfully submits that the alleged impetus to combine Shockley with Beckert in the manner proposed *does not exist*.

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Applicant respectfully submits that while Shockley does state that the "fixed monitoring system (is) disposed within a dashboard of a vehicle" (col. 3, lines 62-65), Shockley very clearly describes control panel 24 and video cassette (26a) recorder (VCR) 26 as a combination TV/VCR unit (col. 4, lines 24-27). Shockley does not teach, or even remotely suggest, that such unit could be modified such that the control panel and TV/VCR are *integrally packaged* and *positioned within a factory-sized radio opening* of a production automobile having a police package option.

The combination of Shockley with Beckett is not proper. For an implicit showing, the test is what "the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); see also MPEP §2143.01(I). Again, Applicant asserts that the nature of the problem in Shockley is visually detecting an apparent condition by viewing a video image of a sub-system (col. 3, lines 30-33). Therefore, it would *not* be obvious to one of ordinary skill in the art to, in light of the teachings of Beckett, replace the control panel, TV monitor and video recorder of Shockley, with the computer system of Beckett in order to provide a single system" (as alleged in the Action). In fact, the combination/modification proposed by the Examiner would eviscerate the very teachings of Shockley to visually monitor auto components. An artisan having common sense at the time of the invention, would not have reasonably considered replacing the control system of Shockley with the computer system of Beckett (while maintaining the video camera to 'visually monitor critical noise levels and/or vibrations'). Rejections "on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning in support of the legal conclusion of obviousness" (*In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int'l v. Teleflex*, 127 S.Ct. 1727 (2007)).

Newly-added independent Claim 21 further recites that the video camera is "fixably mounted to an automobile *for capturing an image of an event in front of the automobile* and producing a corresponding video stream". Shockley's system expressly monitors "sub-system components" and the "interior cab" of the automobile (Col. 5, lines 56-61). There is absolutely no teaching or suggestion of capturing an image 'of an event *in front of the automobile*'.

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Dependent Claims 22-23 further recite that the video camera is mounted on the automobile's dashboard or windshield, respectively, and Claim 24 recites that the video camera has a field of view corresponding to the field of view of a person seated in the front seat of the automobile. Again, Shockley and the other art of record fails to teach or suggest the system defined by Claims 21-24.

For at least the foregoing reasons, each of independent Claims 1, 12 and 21 is believed to be clearly patentable over any permissible combination of the teachings of Shockley, Chuang and Beckert. Dependent Claims 2-7, 13-16 and 18-20 are believed patentable as depending from independent Claim 1 or 12, and for reciting further distinguishing limitations.

In addition, of course to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation *to make the necessary modification of the teaching of the references combined to result in the pending claims*. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPFP §§2142-2143; *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 1596, 1598-99 (Fed. Cir. 1988). The teaching or suggestion to make the claimed *modification* and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure*. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). 706.02(j) [emphasis supplied].

Thus, Applicant respectfully submits that Claims 1-7, 12-16 and 18-24 of the present invention are not taught or suggested by Shockley, Chuang and Beckert and would not be obvious in light of any combination of Shockley, Chuang and Beckert.

Applicant further respectfully submits that it is, of course, improper to pick and choose elements from several references in order to "build" an obviousness rejection, when such a combination would not in fact have been obvious to one of ordinary skill in the art. One of ordinary skill in the art would not have even considered turning to the alleged teachings of Beckert, without the teachings provided by Applicant's disclosure -- which, of course, is not a proper basis for rejection, as it is impermissible to use an Applicants' specification as an instruction manual or "road map" to piece together the teachings of the prior art in order to render claims obvious. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1

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U.S.P.Q.2d 1241 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). Since there is *no teaching* in these references that would suggest each of the elements recited in the present claims, even if one used impermissible hindsight and combined the teachings of the references, the present invention would not be achieved.

Accordingly, Applicant respectfully submits that independent Claims 1, 12 and 21, and dependent Claims 2-7, 13-16 and 18-24, are patentable over any permissible combination of Shockley, Chuang and Beckert.

CONCLUSION

The references relied upon in the Action do not support a *prima facie* case of obviousness. Applicant submits that the pending claims, Claims 1-7, 12-16 and 18-24 are patentable over the art of record and reconsideration and withdrawal of the outstanding rejections are respectfully requested.

Respectfully submitted,


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